



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,573	08/05/2005	Yoshihiro Yoneda	052875	8278

38834 7590 10/15/2009
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

STEITZ, RACHEL RUNNING

ART UNIT	PAPER NUMBER
----------	--------------

3732

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/15/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/544,573	Applicant(s) YONEDA ET AL.	
	Examiner RACHEL R. STEITZ	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 states, "a first adhesive surface layer having a thickness more than half of a diameter of the net member", however, the parameter of the "net member" has not been defined, therefore it is unclear as to what constitutes a thickness more than half the diameter of the net member.

5. Claim 1 states, "a second adhesive surface layer having a thickness equal to or more than a diameter of a hair", however, it is well known in the art that hair can have varying thicknesses depending on the color of the hair and the genetics of the person,

Art Unit: 3732

therefore, applicant has not clearly defined a parameter for the "diameter of a hair" making the scope of the claim indefinite.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Maekawa (US 6,170,491) in view of Gold (US Pub 2004/0237987).

Regarding claim 1, Maekawa discloses a double stick adhesive tape for a wig which as a net member (3) as a portion of the wig base (2) comprising two adhesive surface layers (21a,21b) wherein the first adhesive surface layer has a thickness more than half of a diameter of the net member to stick to the net member (see Figure 1b; column 2, lines 64-68). Since applicant has not specified the parameters of the diameter of the net member, one having ordinary skill in the art at the time the invention was made would have been able to modify Maekawa so that the first adhesive has a thickness more than half of a diameter of the net member, to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Maekawa discloses a second adhesive surface layer (21b) (see Figure 1b). Maekawa does not disclose the second

Art Unit: 3732

adhesive layer having a thickness equal to or more than a diameter of hair wherein the first adhesive layer is thicker than the second surface layer, however, applicant has not clearly defined the parameters of the diameter of a hair, therefore, the parameters of the thickness of the adhesive layer is deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Further Maekawa does not disclose a side of the first adhesive layer being deglossed. Gold teaches an adhesive surface being deglossed (see Figure 8b; paragraph 52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a side of the first adhesive layer to the net member of Maekawa to be deglossed as taught by Gold in order to increase the transpiration of the adhesion.

Regarding claim 3, Maekawa does not disclose the thickness of the first adhesive surface layer having a thickness range between 50 and 200 μm and the second adhesive surface layer side of the adhesive layer having a thickness range between 50 and 150 μm . However, one having ordinary skill in the art would find the parameters of the thickness of the adhesive layers to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Further it is well known in the art to make adhesive layers in the order of microns as evidenced by Shin (US 2002/0056465 paragraph 38).

Regarding claims 5-8, in that the minute concavity and convexity are formed by pressing the adhesive layer with a press having minute saliences, spray-coating granular adhesive, a blasting process, and by a blast process using finely crashed dry

Art Unit: 3732

ice, it is noted that the patentability of a product does not depend on its method of production, therefore, the combination of Maekawa and Gold meets the limitation since the final product consists of minute concavity and convexity. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

8. Applicant's arguments filed September 9, 2009 have been fully considered but they are not persuasive.

9. In response to applicant's argument that Maekawa does not disclose the feature of an adhesive surface to the net member of the wig base, Maekawa does disclose the an adhesive surface (21b) to the net member (2) of the wig base (see Figure 1b).

10. In response to applicant's argument that Maekawa does not disclose the relation of the thicknesses between the adhesive surface layer to the net member the adhesive surface layer to attach the wig, however, since applicant has not clearly defined the parameters of the diameter of a net member the parameters of the thickness of the adhesive layer is deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

Art Unit: 3732

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine comes from Gold, since Gold teaches the use of a discontinuous surface for allowing the transpiration of the adhesive.

12. In response to applicant's argument that the combination of Maekawa and Gold would lack a net member and a deglossed surface on a side of the a second adhesive surface layer, however, this is unclear as to why there would be a deglossed surface on the second adhesive surface since the claim merely states the first adhesive surface layer to the net member being deglossed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL R. STEITZ whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rachel Running Steitz/
Examiner
Art Unit 3732